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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,927	05/09/2001	HORST G. ADOLF	82,141	7227

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Office of Counsel, Code OC4
Naval Surface Warfare Center
Indian Head Division
101 Strauss Avenue, Bldg. D-326
Indian Head, MD 20640-5035

EXAMINER

MILLER, EDWARD A

ART UNIT PAPER NUMBER

3641

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,927

Applicant(s)

SITZAMANN ET AL.

Examiner

Edward A. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 11 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 11 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 11-12 and 21, as best understood, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Kim et al., Barnes et al., Adolph et al. '397, Hostettler, Genz et al., and Okita et al.

Many prepolymers such as claimed, as best understood, are notoriously well known in the prior art and shown for example in Kim et al., Barnes et al., Adolph et al '397, Hostettler and Okita et al. Each of these references teach polyformals, and there is no claim language as best understood to preclude any of the substituents in these references. In Hostettler, note col. 3, lines 10-16, where oxy-ethylene polymers may contain minor amounts of oxy-methylene groups. In Okita et al., note col. 2, lines 11-16 and 40-44, and col. 7, lines 59-65. In Genz et al., note col. 5, lines 35-37. To the extent that the claimed formal moieties are taught or in the chemical structures as shown, properties such as being degradable must be inherent. Even if prepared by another method, the composition is claimed here, and the same thing made by a different method does not become patentable. Where the product appears to be the same or only slightly different, the properties recited would appear to be inherent, regardless of the method of preparation. The Office does not have testing facilities to determine such. The burden falls on applicant to show that the prior art products do not necessarily or inherently possess the claimed properties. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966; *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596; *In re Best*, 562 F.2d 1252, 1255; 195 USPQ 430, 433-434; *In re Brown*, 459 F.2d 531, 173 USPQ 685. To the extent necessary, variation of well known parameters such as the molecular weight would have been obvious to one of ordinary skill in the art. It is well settled that optimizing a result effective variable is well within the expected ability of a

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person or ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

3. Claims 10-11 and 21, as best understood, are rejected under 35 U.S.C. 103(a) as unpatentable over Emmerling et al., in view of Hostetter et al., Okita et al. and Genz et al.

Emmerling et al. teaches the basic invention of polyols, which may be prepared from many precursors. Included in these is hydroxy-terminated polyesters, including from polycaprolactone, col. 2, lines 66-67. Further, in col. 3, lines 1-20, especially lines 5-8, and also lower down in lines 39-42, the use of polyols for reaction may include polyacetals from formaldehyde, e.g. Reaction of such with caprolactone to form the expected polyol as taught would have been obvious. Hostetter et al., Okita et al. and Genz et al., as set forth in the above paragraph, further teach polyols containing formal groups that may be reacted with caprolactone to produce a hydroxy terminated polyester polyol. In Hostetter et al., col. 3, lines 10-16, it is particularly noted that oxy-ethylene polymers may contain minor amounts of oxy-methylene groups. Thus, it is deemed obvious to prepare the desired polyols with interior formal groups as claimed, as best as the claims are understood. Variation of specific moieties and amounts including molecular weights would have been obvious to one of ordinary skill. It is well settled that optimizing a result effective variable is well within the expected ability of a person or ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

4. Claims 10-11 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims, the "R" language is improper and indefinite chemical terminology and does not provide a reasonable definition of the invention. The "R" recitation, that R "contains" certain

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named atoms is indefinite. "Contains" has the broad scope of "comprises". Thus, the language chosen does not limit the claims as applicants urge. There is no correction of the language of claims 10 or 11 to the language of claim 21. It cannot be reasonably determined what is meant in claim 10, line 2, as to polycaprolactone. The language limiting "R" requires certain atoms including C, H and O, being single bonded to each other. This precludes a double bond, but which is required for any ester group. As polycaprolactone includes the ester group, this language is incorrect. The claims are inconsistent. In claim 11, there is no relationship to the functionality limitation of claim 11 and the "n" limitation in claim 21. Perhaps the "contains" broad scope for R in claim 21 obviates the molecular weight limitation of 500 in claim 10. The language used fails to define the metes and bounds of the claims.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
May 19, 2003



EDWARD A. MILLER
PRIMARY EXAMINER